

REMARKS

Claims 1-33 are pending in the application, claims 1, 2, 5, 12, 14 and 21 amended as set forth above.

In this paper, claim 1 has been amended as discussed below to more particularly point out what Applicant regards as her invention; claims 2 and 5 have been amended for the same reason as claim 1 and to comport with the amendment with that claim; claim 14 has been amended to add a period at the end of the claim; and the article "a" is added in claim 21. Applicant asserts that none of these amendments are necessary for patentability, nor do any of them affect the scope of the claims.

In the official action issued February 28, 2006 the Examiner acknowledged Applicant's election of the claims of Group I (Claims 1-33) for examination on the merits.

Objection to Claim 1

In the official action of February 28, 2006, claim 1 was objected to on the grounds that the pronouns "that" and "it" were alleged to render the claim indefinite. Applicant respectfully disagrees with the rejection and maintains that the original language of the claim is as clear as it is grammatical. Nevertheless, in the interest of expediting prosecution, applicant has amended claim 1 to more particularly point out what Applicant regards as her invention and, in so doing, has addressed the objection. Therefore, Applicant respectfully submits that the objection to claim 1 for alleged indefiniteness should be withdrawn.

Rejection of Claims 1, 2, 3, 5 and 6 under 35 U.S.C. §102(e)

A rejection on the ground of anticipation under any paragraph of 35 U.S.C. §102 requires that the U.S. Patent and Trademark Office carry the heavy burden of showing that each and every

limitation of the claim be shown by a single prior art reference. The Examiner has failed to carry that burden.

According to the official action, language in the preamble and allegedly functional statements such as "adapted to" and "whereby" are given no patentable weight. Accordingly, with those limitations having been read out of the claims, they were rejected under 35 U.S.C. §102(c) as allegedly anticipated by U.S. patent 5,76,132 to Hill.

The Examiner is also directed to *In re Duva*, 156 USPQ 90 (CCPA 1967), where the U.S. Court of Customs and Patent Appeals, the predecessor of the U.S. Court of Appeals for the Federal Circuit, held that preamble language may not be ignored in determining patentability. In this instance, preamble language provides context for the limitations of the claims but is not required for their examination or patentability. However, the Examiner is not at liberty to disregard them for all purposes, including their contextual value, as though the language was not even there. Yet the entire rejection hinges to a significant extent on precisely this error (and numerous others addressed below).

Applicant respectfully but strenuously disagree with the Official Action. The Official Action has impermissibly ignored the clear structural recitation of the claim both prior to and after amendment: the housing having a shape substantially similar to the shape of an article into which it is inserted. The Examiner's premises are fundamentally mistaken: This language is neither (1) preamble language, nor (2) functional language.

The Examiner has not set forth any basis for believing that the above-quoted language is anything but structural: Shape is the very essence of structure. Applicant has not simply recited functional language.

The Examiner has referred and objected to "whereby" language – but that is present only in claim 13 and Applicant does not stress that language for purposes of patentability.

The Examiner has also referred and objected to "adapted to" language, but language of that sort, like the whereby language, is limited to claims 13 and 22. Moreover, the Examiner has supplied no authority for this sweeping, and incorrect, legal conclusion.

The Examiner's position, in addition to being without basis on its face, would lead to the illogical result that Applicant would need to positively claim the object recited in the preamble, and could only accuse both the object and the lighting devices of infringement.

Despite these errors, in order to expedite prosecution of the application, Applicant has amended claim 1, without diminution in scope, to more particularly point out the claimed invention and in such a manner as to eliminate preamble language the Examiner alleges was objectionable and in order to underscore the structural nature of the limitations. In particular, the final limitation of the claim, as now amended, recites: "a housing, containing the light source and the power supply, for insertion into an interior portion of an article having a preselected shape, the housing having a shape substantially similar to the shape of the article into the interior of which the light source is inserted."

In view of the clear errors forming the basis of the rejection, reading the language of the above-identified claims properly— *as written* (and as now amended) — the Examiner has failed to present a prima facie case of unpatentability of the claimed invention. He has not even attempted to show how the Hill reference shows the housing having a shape substantially similar to the shape of the article into which it is inserted. See Official Action at page 3, item 10.

More particularly, the Hill '132 patent relied on by the Examiner discloses an illumination device of rectangular cross section and a ladies' purse (12), the interior of which is lined by

pockets to provide a complex non-rectangular shaped interior wherein the walls are defined by the outer surface of the pockets. In fact, nowhere in the Hill '132 patent is there any disclosure of a device for illuminating an interior portion of an article, wherein the shape of the device is substantially similar to the shape of an article, into the interior of which the lighting device is inserted.

Therefore, since the cited reference fails to identically disclose each and every limitation of the claim, claim 1 cannot be anticipated by the Hill '132 patent, and the rejection of claim 1 under 35 U.S.C. §102(e) must be withdrawn. Similarly, since claims 2, 3, 5 and 6 are dependent claims that incorporate all the elements of claim 1, these claims also include the structural limitation that the shape of the device is substantially similar to the shape of the article into the interior of which the lighting device is inserted. For the same reason as given above, these claims cannot be anticipated by the Hill '132 patent, and the rejection of claims 1-3 and 5-6 under 35 U.S.C. §102(e) must be withdrawn.

Rejection of Claims 1, 2, 3 and 4 under 35 U.S.C. §102(b)

In the official action of February 28, 2006, claims 1, 2, 3 and 4 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent 5,975,713 to Brothers. As with the Hill reference, and for similar reasons, the Examiner has also failed to carry the significant burden of demonstrating that the claims, in all of their limitations, are identically shown by a single prior art reference.

As argued above, which argument is incorporated by reference in its entirety, the premises of this rejection — involving the wholesale neglect of clear structural claim limitations — the Examiner has impermissibly excised language of the claims in an attempt to prop up a baseless

rejection. No attempt has been made to demonstrate how the omitted structure is shown by the prior art. For this reason alone, the rejection is without merit and must be withdrawn.

Looking more closely, the Brothers '713 patent does not disclose a device for illuminating an interior portion of an object, wherein the shape of the lighting device is substantially similar to the shape of an article into the interior of which it is inserted, as required by amended claim 1.

The Brothers '713 patent discloses an illumination device having a rectangular cross section, for illumination of a mailbox having a top with a semicircular cross section and a flat base with perpendicular walls rising at a right-angled from the flat base. The illumination device is completely devoid of any curved surfaces and therefore cannot be substantially similar in shape to the mailbox which it illuminates. Thus, the Brothers '713 patent fails to disclose a lighting device for insertion into an article having a preselected shape, and having itself a shape substantially similar to that article's preselected shape. Therefore, again, since the reference fails to disclose at all, much less identically, each and every element of the claim, claim 1 cannot be anticipated by the Brothers '713 patent.

Similarly, since claims 2, 3 and 4 are dependent claims that incorporate all the elements of claim 1, these claims also include the limitation whose absence from the cited art has been described above. For the same reason as given above, these claims cannot be anticipated by the Brothers '713 patent, and the rejection of claims 1-4 under 35 U.S.C. §102(e) in view of the Brothers '713 patent must be withdrawn.

Rejection of Claims 7, 8, 9, 10 under 35 U.S.C. §102(b)

In the official action, claims 7, 8, 9 and 10 were rejected as allegedly anticipated under 35 U.S.C. §102(b) by the U.S. patent 5,76,132 to Hill. However, contrary to the assertion in the office action, nowhere in the Hill '132 patent is there any disclosure of "an aperture [] for the passage of light" (claim 7, first limitation).

Figures 1 and 3 are cited as disclosing an aperture, whereas, in fact, Figures 1 and 3 show a bulb mounted in the bottom surface of an illumination device. That device has no aperture for the passage of the light from the bulb. This element is absent from the disclosure of the Hill '132 patent.

Therefore, since Hill fails to identically disclose every recited element, claim 7 and dependent claims 8-10 (which necessarily incorporate this limitation) cannot be anticipated by the Hill '132 patent. The rejection of claims 7-10 under 35 U.S.C. §102(e) must accordingly be withdrawn.

Rejection of Claims 7 and 11 under 35 U.S.C. §102(b)

In the official action, claims 7 and 11 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent 5,975,713 to Brothers. According to the Office action, Figure 2, object 12 of the Brothers '713 patent discloses a housing having an interior and an aperture therein for the passage of light. In fact, the bulb 16 is mounted directly on the outer surface of the housing 12, and the housing 12 is wholly devoid of any aperture for the passage of light.

Therefore, claim 7 cannot be anticipated by the disclosure of the Brothers '713 patent. Furthermore, claim 11, which depends from claim 7 and thus necessarily incorporates each and every limitation of claim 7, also cannot be anticipated by the disclosure of the Brothers '713

patent. For these reasons, the rejection of claims 7 and 11 under 35 U.S.C. §102(e) as allegedly anticipated by the Brothers '713 patent cannot stand and must be withdrawn.

Rejection of Claims 12 and 22 under 35 U.S.C. §102(b)

Claims 12 and 22 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent 5,018,057 to Biggs.

Claim 12 has amended for purposes other than patentability and in a manner that does not reduce the scope of the claim. As amended, claim 12 recites, among other things, a "device comprising: (a) a housing in the shape of a fashion accessory, the housing having an interior, a top portion, and a bottom portion, wherein the interior extends from the bottom portion to the top portion of the housing".... Claim 12 has been amended to substitute "coupled" for "removeably attached" in element (b) relating to a recited light source.

According to the office action, the Biggs '057 patent provides:

- a housing (Figure 1, object 12) having a hollow interior, a top portion, and a bottom portion, wherein the hollow interior extends from the bottom portion to the top portion of the housing (12);
- a light source module (Figure 1, 10) removeably attached (Figure 4, 38) to the top portion of the housing (Figure 1, 12) and extending substantially downward within the hollow interior toward the bottom portion; and
- a handle (Figure 1) attached to the top portion of the housing (12).

However, the office action fails to identify, and the Biggs '057 patent does not disclose, the all of the limitations of claim 12, and excludes at least the following:

- "a housing in the shape of a fashion accessory"; and

--“the handle securing the device to a member within an article having substantially the same shape as the housing, wherein the device illuminates the article interior.” The lighting device has not even been alleged to disclose a housing in the shape of a fashion accessory, nor has the Official Action even attempted to show that the claimed device has substantially the same shape as the article within which it is secured. The Biggs ‘057 patent emphatically lacks any such disclosure. Therefore, the Biggs ‘057 patent fails to disclose every element of claim 12, and cannot anticipate this claim. Similarly, since claim 22 depends from claim 12, Biggs ‘057 patent fails to disclose every element of claim 22.

Moreover, Applicants vehemently reject the assertion at page 7 of the office action that the housing (Figure 1, 12) is in the shape of the handbag. The Biggs ‘057 refers to the device simply as “a light module 10” (e.g., col. 2, lines 28-29) and that it “in general comprises a relatively narrow, oblong shaped case or housing....” (id. at lines 34-36) and that it “may have a plan form size as small as approximately one-half the size of a standard credit card and a thickness as small as 0.25 inches, thereby enabling a module to be installed in a wide range of confined and/or normally inaccessible locations” (id. at col. 2, line 65 to col. 3, line 2). Thus, even where Biggs discussed the structure of the light source at all, no mention was made of it resembling any object other than, perhaps, a credit card — an object lacking any interior capable of being illuminated. Plainly, Biggs discloses nothing of any relevance to the claimed invention whatever.

For these reasons, the rejection of claims 12 and 22 under 35 U.S.C. §102(e) as allegedly anticipated by the Biggs ‘057 patent is without merit and must be withdrawn.

Rejection of Claim 14 under 35 U.S.C. §103(a)

Claim 14 was rejected as allegedly unpatentable under 35 U.S.C. §103(a) over the Biggs ‘057 patent in view of U.S. Patent 6,663,265 to Kovacic et al. According to the official action,

Biggs discloses every element of claim 14 except the "handle comprises a hinge for manipulating the handle between a first and second position, wherein manipulating the handle to the first position facilitates carriage of the illumination device, and manipulating the handle to the second position facilitates securing the illumination device to the member within the article that the illumination device is illuminating."

To begin with, as discussed above in connection with claim 12, Biggs does not disclose the limitations of claim 12, from which claim 14 depends and all of whose limitations it incorporates. The Kovacik '265 patent is not alleged to supply the limitations missing from Biggs, and, in fact, does not supply them. For this reason alone, the alleged unpatentability of claim 14 is meritless.

The Kovacik '265 patent is alleged to disclose a handle (16) of a lighting module (Figure 5) having these features. In fact handle (16) does not disclose, suggest or even hint at a "hinge for manipulating the handle between a first and second position." The switch does not manipulate the handle between a first and a second position, much less "facilitate[s] securing the illumination device to the member within the article that the illumination device is illuminating" as required by claim 14.

In fact, even if any of the features disclosed in the Biggs '057 patent and the Kovacik '265 patent were combined, they would still fail to provide any suggestion of a "hinge for manipulating the handle between a first and second position," as claimed.

Therefore, for the reasons set forth above, the combination of the disclosures of the Biggs '057 patent and the Kovacik '265 patent does not render the invention of claim 14 obvious, and this rejection of claim 14 under 35 U.S.C. §103(a) over the Biggs '057 patent in view of U.S. Patent 6,663,265 to Kovacik et al. must be withdrawn.

Rejection of Claim 15 under 35 U.S.C. §103(a)

Claim 15 is rejected under 35 U.S.C. §103(a) as allegedly obvious over the Biggs '057 patent in view of U.S. Patent 2,288,996 to Dubilier. According to the office action, the Biggs '057 patent discloses the invention substantially as claimed except for a handle having a hinge for a housing having a substantially transparent bottom portion. Allegedly this feature is supplied by the disclosure of the '996 patent of Dubilier.

However, as explained in detail above, the lighting device disclosed in the Biggs '057 patent does not have the shape of a fashion accessory, nor is the shape substantially the same as an article to which it is secured to illuminate its interior, as required by claim 15 or claim 12 from which it depends. The '996 patent of Dubilier adds no hint or suggestion, let alone any such disclosure, to address this glaring defect in the grounds for rejection. The combination of the disclosures of the Biggs '057 patent and the '996 patent of Dubilier, therefore, cannot be held to render claim 15 unpatentable for obviousness under 35 U.S.C. §103(a). The rejection must therefore be withdrawn.

Furthermore, the cited '996 Dubilier patent discloses a mesh or screen side portion, and does not suggest or even hint at a substantially transparent bottom portion as required by claim 15. Thus, the rejection of claim 15 under 35 U.S.C. §103(a) as allegedly unpatentable over the Biggs '057 patent in view of U.S. Patent 2,288,996 to Dubilier is unsupported and must be withdrawn.

Rejection of Claims 12, 13, 16, 18, 17 and 19 under 35 U.S.C. §103(a)

Claims 12, 13, 16, 18, 17 and 19 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent 5,070,438 to Marshall in view of the Biggs '057 patent. The Marshall '438 patent discloses a pen-light.

This rejection is misplaced, for several reasons. To begin with, the combination of the pen-light disclosure of the Marshall '438 patent with the disclosure of the Biggs '057 patent is improper, since the disclosures of Marshall and Biggs are drawn from different fields. The Marshall '438 patent relates to pen lights, not "a device having a housing in the shape of a fashion accessory as required by each of claims 12, 13, 16, 18, 17 and 19. The Biggs '057 patent allegedly discloses a "touch initiated light module" (as titled) of a distinct field of art and nowhere suggests or invites the combination with a pen-light as disclosed by the Marshall '438 patent. The combination, rather, improperly enlists applicant's disclosure as a road map. For this reason alone, the rejection is without merit and should be withdrawn.

Furthermore, even if the combination were permitted, which it is not, the combination would not disclose the devices of claims 12, 13, 16, 18 and 19. As explained several times and in detail above, the fashion accessory disclosed in the Biggs '057 patent does not have substantially the same shape as the housing as required by claim 15 and each of the previously-discussed claims.

Therefore, the rejection of claims 12, 13, 16, 18 and 19 under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent 5,070,438 to Marshall in view of the Biggs '057 patent cannot be sustained and must be withdrawn.

Rejection of Claims 16 and 20 under 35 U.S.C. §103(a)

Claims 16 and 20 were rejected as allegedly unpatentable under 35 U.S.C. §103(a) over the Marshall '438 patent and the Biggs '057 patent and further in view of U.S. patent 6,893,143 to Opolka. According to the official action, the Marshall '438 patent and the Biggs '057 patent disclosures provide all but a switch device comprising a pressure-activated component (as required by claim 16) and a luminescent device comprising a light-emitting diode (LED, as required by

claim 20). The Opolka '143 patent allegedly describes switches for turning the light on and off, and LEDs as light sources. The addition of the lounge, table or pocket lamp disclosure of the Opolka '143 patent to the combination of the Marshall '438 patent and the Biggs '057 patent is alleged to render obvious claims 16 and 20.

Claims 16 and 20 recite devices having, among other recited features, one or more pressure-sensitive switches or LEDs. The disclosure of the Opolka '143 patent fails to supply the feature admittedly missing from the combination of the Marshall and Biggs patent disclosures as explained at length above. This rejection is untenable, as there is no hint or suggestion of a device shaped like a fashion accessory or having a shape substantially the same as an article the interior of which it illuminates..

Therefore, the rejection of claims 16 and 20 under 35 U.S.C. §103(a) as allegedly unpatentable under 35 U.S.C. §103(a) over the Marshall '438 patent and the Biggs '057 patent and further in view of the Opolka '143 patent cannot be sustained and must be withdrawn.

Rejection of Claims 17 and 18 under 35 U.S.C. §103(a)

Claims 17 and 18 were rejected as allegedly unpatentable under 35 U.S.C. §103(a) over the Marshall '438 patent and the Biggs '057 patent and further in view of U.S. patent 6,848,807 to Guerrieri. According to the office action, the Marshall '438 patent and the Biggs '057 patent disclosures provide all but a switch device comprising a voice recognition device (as required by claim 17), and a switch device comprising a timing device for deactivating the luminescent device after a predefined time period.

However, contrary to this assertion, the Marshall '438 patent and the Biggs '057 patent disclosures, even in combination with the Guerrieri '807 patent, fail to suggest or even so much as

to hint at a device shaped like a fashion accessory or having a shape substantially the same as an article the interior of which it illuminates.

For this reason at least, this rejection of claims 17 and 18 were rejected as allegedly unpatentable under 35 U.S.C. §103(a) over the Marshall '438 patent and the Biggs '057 patent and further in view of U.S. patent 6,848,807 to Guerrieri cannot be maintained and must be withdrawn.

Rejection of Claim 21 under 35 U.S.C. §103(a)

Claim 21 was rejected as allegedly unpatentable under 35 U.S.C. §103(a) over the Marshall '438 patent and the Biggs '057 patent and further in view of U.S. patent 3,963,914 to Browning. According to the office action, the Marshall '438 patent and the Biggs '057 patent disclosures together provide all but "a second luminescent device disposed between a securing cap and a second end of the battery barrel[.]"

However, as stated above and contrary to this assertion, the Marshall '438 patent and the Biggs '057 patent disclosures, even in combination with the Guerrieri '807 patent, fail to suggest or even so much as to hint at a device shaped like a fashion accessory or having a shape substantially the same as an article the interior of which it illuminates, as set forth in base claim 12. Further, and again as stated above, the addition of the Browning reference does not cure the defect of combination of Marshall and Biggs.

Nowhere in Browning is there any suggestion of a device having all of the recited limitations. For this reason at least, this rejection of claim 21 as allegedly unpatentable under 35 U.S.C. §103(a) over the Marshall '438 patent and the Biggs '057 patent and further in view of U.S. patent 3,963,914 to Browning cannot be maintained and must be withdrawn.

Rejection of Claims 23-25, 27-30 and 32-33 under 35 U.S.C. §103(a)

Claims 23-25, 27-30 and 32-33 were rejected as allegedly unpatentable under 35 U.S.C. §103(a) over the Biggs '057 patent. According to the Office Action, the structural limitations claimed in the method claims 23-25, 27-30 and 32-33 are met by the disclosure of the Biggs '057 patent and it is alleged that it would have been on its face obvious to modify the light module of Biggs to obtain sufficient illumination of a desired area.

In fact, nowhere in the disclosure of the Biggs '057 patent is there any hint of "a portable illumination device in the shape of the article for reminding a user to place the illumination device in the article" as required by claim 23 and dependent claims 24-25, 27-30 and 32-33. It is the examiner's burden to provide a reasoned explanation to show how the cited reference renders obvious this feature of the rejected claims. This, the examiner has utterly failed to do. The mere conclusory statement that this would have been prima facie obvious from the disclosure of the Biggs '057 patent does not meet this requirement.

For this reason at least, this rejection of claims 23-25, 27-30 and 32-33 as allegedly unpatentable under 35 U.S.C. §103(a) over the Biggs '057 patent cannot be maintained and must be withdrawn.

Rejection of Claims 23 and 26 under 35 U.S.C. §103(a) Guerrieri

Claims 23 and 26 were rejected as allegedly unpatentable under 35 U.S.C. §103(a) over U.S. patent 6,848,807 to Guerrieri. According to the Office Action, it would have been obvious on its face to modify the light module of the '807 Guerrieri patent to obtain sufficient illumination of a desired area.

This explanation fails to carry the Examiner's burden and fails to establish a prima facie case of unpatentability. As stated above, it is the examiner's burden to provide a reasoned

explanation to show how the cited reference renders obvious this feature of the rejected claims. This, the examiner has again failed to do. A mere conclusory statement that this would have been prima facie obvious from the disclosure of the Biggs '057 patent fails to meet this stringent requirement. Furthermore, even if it were true that it would have been obvious to modify the light module of Gurrieri to obtain sufficient illumination of a desired area, the limitation that the portable illumination device be "in the shape of the article for reminding a user to place the illumination device in the article" is nowhere suggested in the '807 Gurrieri patent.

For these reasons at least, this rejection of claims 23 and 26 as allegedly unpatentable under 35 U.S.C. §103(a) over the '807 Gurrieri patent cannot be maintained and must be withdrawn.

Rejection of Claims 23 and 31 under 35 U.S.C. §103(a)

Claims 23 and 31 were rejected as allegedly unpatentable under 35 U.S.C. §103(a) over U.S. patent 5,764,132 to Hill. According to the Office Action, it would have been obvious on its face to modify the light module of the '132 Hill patent to "provide a method of illumination for the portable lighting source of Guerrieri, in order to obtain sufficient illumination of a desired area(s).

It is unclear to Applicant whether the examiner intends the rejection to be based on the '132 patent of Hill and/or the '807 patent of Gurrieri. In any case, however, the rejection fails both for failure to provide a reasoned explanation of how the stated limitation is reached from the cited disclosure, and because neither the '132 patent of Hill nor the '807 patent of Gurrieri alone or in combination suggest a portable illumination device be "in the shape of the article for reminding a user to place the illumination device in the article[.]"

Therefore, for these reasons at least, this rejection of claims 23 and 31 as allegedly unpatentable under 35 U.S.C. §103(a) over the '132 patent of Hill and/or the '807 patent of Currier cannot be maintained and must be withdrawn.


Request for reconsideration

Applicants respectfully request entry of the above amendments and reconsideration of the objection and rejections recited in the office action of February 28, 2006 based on the above amendments and arguments.

The Commissioner is authorized to charge the/any required fee for an extension of time and any other fee required to maintain pendency of the above-captioned application to Deposit Account No. 23-1703.

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Respectfully submitted,



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